

### III. REMARKS

In this Amendment, claims 1, 6, 11, 14, 19, 21, and 26 have been amended. All amendments are supported by the specification. In particular, claims 1, 6, 14, and 21 have been amended to recite “wherein the prompt object is an object separate from the report such that the prompt object may be used more than once in a single report or may be used in more than one report.” This amendment is supported in the specification by at least the following passage:

The basic functionality of prompts is to “ask a question and get an answer.” Additionally, prompts may provide the following additional features. Prompts can be shared between several objects. When several objects in a report use the same prompt, the question may be asked only once. Each prompt may have a default value. This value can be used when the report is executed offline (e.g., through the use of the scheduler). This value is also useful to the GUI when presenting a prompt to the user. Depending on the type of question that a prompt object asks, a creator of a prompt object may express restrictions on the set of values that are acceptable as answers of the question. The system may thus validate the answer to a prompt. Answers given to any or all of the prompts in a report may be saved. When a report definition is given to the report server to be executed, the saved answers may be used instead of questioning the user. When the report server asks the GUI to resolve a prompt, the report server makes the saved answer available for possible use by the GUI. The answers saved from one report can be applied to the execution of a different report. It is possible to specify that a saved answer to a specific prompt should be used without prompting the user to answer the prompt again. In this case no call back may be made to the GUI to answer these prompts.

Specification, p. 14, line 13 - p. 15, line 6.

Claims 2-5, 7-10, 12, 13, 15-18, 20, and 22-25 remain unchanged.

In sum, claims 1-28 are pending after entry of this Amendment.

#### A. Information Disclosure Statement

According to the Office Action, the information disclosure statement filed 9/23/02 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because some documents were not included in the CD as cited and some have no date. Applicants will address these issues in a subsequent correspondence such as a supplemental IDS, if necessary.

**B. Double Patenting**

***(1) Provisional rejection of claims 1 and 3 under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 5 of copending Application No. 09/883,303.***

Claims 1 and 3 stand provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1 and 5 of copending U.S. Application No. 09/833,303 (“the ‘303 application”). The Office Action asserts that claims 1 and 3 are coextensive in scope with claims 1 and 5 of the ‘303 application, respectively.

Under 35 U.S.C. §101, two patents cannot issue on the same invention. “Same invention” means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1940); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957). A reliable test for double patenting under 35 U.S.C. §101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

It is possible to infringe claims 1 and 3 of the instant application without infringing claims 1 and 5 of the ‘303 application. Amended claim 1 recites a “prompt object...wherein the report may specify a prompt object as a property of the report.” (The underlined language was not added to the claim but was moved from the preamble to the claim body.) Claim 1 of the ‘303 application recites an “object-type prompt object” comprising a question “to be asked of a user that asks the user to identify an object for processing the report.”

It should first be noted that claim 1 of the instant application and claim 1 of the ‘303 application have different scopes in at least three different respects. First, claim 1 of the ‘303 application does not recite “wherein the report may specify a prompt object as a property of the report.” Second, claim 1 of the instant application does not recite that the prompt object is an *object-type* prompt object, which is a particular kind of prompt object. Third, claim 1 of the

instant application does not recite that the question is “*to be asked of a user that asks the user to identify an object for processing the report.*”

There are embodiments that would infringe claim 1 of the instant application but not claim 1 of the ‘303 application. One such embodiment is a prompt object that has all the recitations of claim 1 of the instant application wherein the question does not ask the user to identify an object for processing the report. Another such embodiment has the features of claim 1 of the instant application, wherein the prompt object is not an “object-type” prompt object. Thus, claim 1 of the instant application and claim 1 of the ‘303 application are not co-extensive. It is also noted that claim 1 of the instant application recites “wherein the prompt object is an object separate from the report such that the prompt object may be used more than once in a single report or may be used in more than one report,” which is not recited in claim 1 of the ‘303 application.

Claim 3 of the instant application incorporates all the recitations of its parent claim, as does claim 5 of the ‘303 application. These claims are not co-extensive for at least the reasons discussed above with respect to their parent claims.

For at least these three reasons, Applicants respectfully request that the instant provisional rejection of claims 1 and 3 be withdrawn.

***(2) Claims 6 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 and 10 of copending Application No. 09/883,303.***

Claims 6 and 8 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 6 and 10 of the ‘303 application. The Office Action further stated that a Terminal Disclaimer may be filed to overcome this provisional rejection. Applicants note that a Terminal Disclaimer is proper because the two applications are commonly owned.

Accordingly, Applicants are filing herewith a Terminal Disclaimer to overcome this rejection, and it is respectfully requested that the instant provisional rejection of claims 6 and 8 be withdrawn.

**C. Rejection of Claims 1, 6, and 21 Under 35 U.S.C. §101**

Claims 1, 6, and 21 were rejected under 35 U.S.C. §101 because the claimed invention is purportedly directed to non-statutory subject matter. The Office Action suggested that this rejection may be overcome by amending the claims to recite language relating to computer-implemented actions or embodiments in a computer-readable medium.

As suggested in the Office Action, these claims have been amended to overcome these rejections. Amended claim 1 recites “[a] prompt object on a computer-readable medium.” Amended claim 6 recites “[a] computer-implemented method.” Amended claim 21 recites “report selection means embodied on a computer-readable medium .”

Accordingly, Applicants respectfully request that the instant rejection of claims 1, 6, and 21 be withdrawn.

**D. Rejection of Claims 1-28 Under 35 U.S.C. §103(a) Over Thompson**

Claims 1-28 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,668,253 to Thompson et al. (“Thompson”). Thompson discloses “a transformation and staging server connected to [a] data warehouse server...; a financial consolidation application connected to the transformation and staging server for performing consolidation and reporting of financial data; a web server connected to the data warehouse server; and a plurality of clients connectable to the web server for accessing data from the data warehouse server via the web server.” Thompson Abstract. In Thompson, users may view reports and interact with data processed at a central processing system.

**1. Thompson does not disclose or suggest a separate “prompt object”**

As amended, independent claims 1, 6, 14, and 21 recite a “prompt object...wherein the prompt object is an object separate from the report...such that the prompt object may be used more than once in a single report.” Claims 2-5, 7-13, 15-20, and 22-28 depend from claims 1, 6, 14, and 21 and thereby incorporate this feature by reference. Although Thompson discloses *prompts*, Thompson does not disclose a “prompt *object*” (emphasis added). A prompt object is an object embodied in software code that exists separate from the reports, filters, and templates (and the like) that use them.

Thompson does not disclose a “prompt object” because the prompts in Thompson are not software objects that exist separate from the filters, templates, and reports that use them. Thompson discusses “Ad Hoc Report Creation” wherein a user may drag and drop various data elements in any order and select various filters for creation of the report. Thompson, col. 10, line 63 to col. 11, line 15. This is inconsistent with the use of a “prompt object” of the present invention, which can be used to prompt a question and validate a user answer. Rather, in at least this passage of Thompson -- which describes a more free-form approach to report creation -- there are no identifiable “questions” and “answers,” and therefore there are no “prompts” of any kind. Another passage of Thompson cited against the claims is the section entitled “Auto Prompting.” Thompson, col. 10, lines 1-16. This section does not anticipate the claims because it does not disclose or suggest a prompt object.

There is no indication in Thompson of any prompts that are “an object separate from the report...such that the prompt object may be used more than once in a single report,” as recited in claims 1, 6, 14, and 21. Claims 2-5, 7-13, 15-20, and 22-28 depend from claims 1, 6, 14, and 21 and thereby incorporate this feature by reference.

For at least these reasons, Applicants respectfully request that the instant rejection of claims 1-28 be withdrawn.

**2. Thompson does not disclose or suggest a “validation property”**

Independent claims 1, 6, 14, and 21 recite “[a] prompt object compris[ing] at least one validation property.” Claims 2-5, 7-13, 15-20, and 22-28 depend from claims 1, 6, 14, and 21 and thereby incorporate this feature by reference. As stated in the Office Action, Thompson does not disclose the prompt object’s “at least one validation property.” Instead, the Office Action asserts that Thompson discloses “the ability to create user definable parameters for querying the data warehouse and filtering information, and the filters provide[] the report with parameters to narrow the selection of data displayed.” Office Action, p. 7. The Office Action also states that it would have been obvious to modify Thompson to include at least one validation property. The Office Action provides the rationale that “[q]uerying the warehouse and filtering data retrieved for the report suggests *searching in a data warehouse for an object addressed in a query* to populate in the report since it was well known in the art that searching is a subsequent step when a query is made.” Office Action, p. 8 (emphasis in original). The Office Action goes on to conclude that Thompson’s “user defined parameter is considered as the validation property comprised in the prompt for conducting the query search and *rendering a suitable answer* to said query.” Office Action, p. 8 (emphasis in original).

Applicants first note that the Examiner’s conclusion seems to suggest an additional rejection under §102 because it seems to allege that Thompson’s user-defined parameter discloses a “validation property.” Notably, the Office Action did not explicitly reject the claims under §102 precisely because, according to the Office Action, “Thompson does not explicitly disclose that the prompt object comprises at least one validation property.” Office Action, p. 7. Applicants further note that Thompson’s “user defined parameter” cannot properly be considered

a component of a “prompt object” as recited in the claims because it is, if anything, a *response* to a prompt, not a part of the prompt itself. A user defined parameter cannot be part of a prompt in the same way that an answer from one party provided in response to a question from another party cannot be considered part of the question.

In regard to the Office Action’s assertion that it would have been obvious to a skilled artisan to combine a “validation property” with Thompson’s invention to create a prompt object as recited in the claims, Applicants respectfully disagree. Thompson discloses user definable parameters as follows:

**Auto Prompting**

EIM provides the ability to create user definable parameters for querying the data warehouse and filtering information. These filters provide the report with parameters to narrow the selection of data displayed. The user can be automatically prompted to provide values for these parameters or the filter can have pre-defined values established. If the parameter is a hierarchy, the filter provides the capability to select one or more values at any level within the hierarchy. Filter selection takes place in a pop-up dialog window. Standard windows actions provide either double-click or drag-and-drop selection of values. For more complex parameters, the dialog provides a wizard and online user assistance to aid the user in making a selection. FIG. 5 shows an example of auto-prompting for report parameters according to embodiments of this invention.

Thompson, col. 10, lines 1-16. It should be noted that FIG. 5, referenced in the passage above, shows an “autoprompt” window that contains a list of dealerships from which a user may choose in one box and the user’s current selections in another box.

Thompson’s “user definable parameters” for “narrow[ing] the selection of data displayed” do not disclose or suggest a “validation property” comprised in a prompt object as recited in the claims. Generally speaking, user definable parameters would not necessarily require verification. Presumably, an example of a user defined parameter might be the parameter “>\$100,000” to specify a filter that will return data for companies having a revenue greater than \$100,000 in a given month. A system similar to that of Thompson may simply execute this filter

(or another user definable parameter), without executing any verification action. If there are no companies satisfying the criteria, then the resulting report may include zero companies. If the reporting system does not recognize the comma in “>\$100,000”, the reporting system may refuse to process the report and instead return a formatting error. In other words, the mere existence of a “user definable parameter” does not disclose or suggest a “validation property” as recited in the claims.

Furthermore, there is nothing in Thompson to suggest that any validation property would be comprised in a prompt object. Although FIG. 5 shows selecting a filter from among predefined choices, it does not show a validation property comprised in a prompt object. Validation of a response to a question may be accomplished in any of a variety of systems and methods. Comprising a question and a validation property within a single, separate prompt object is a novel feature of the present invention. Thus, even if a validation property were somehow combined with Thompson, there is no motivation to have the validation property comprised in the prompt object itself, rather than elsewhere in the Thompson system. If such a motivation exists, Applicants respectfully request the Examiner to explain such motivation.

For at least these reasons, Applicants respectfully request that the instant rejection of claims 1-28 be withdrawn.

As noted in the Office Action, the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants acknowledge that they were advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).



**E. Formal Objection to Claims 11, 19, and 26**

Claims 11, 19, and 26 are presently objected to because of informalities. Claims 11, 19 and 26 have been amended to overcome the current claim objections. Therefore, Applicants respectfully request that these objections be withdrawn.

#### IV. CONCLUSION

For all the reasons set forth above, it is respectfully submitted that all outstanding objections and rejections have been overcome or rendered moot. Further, all pending claims are patentably distinguishable over the prior art of record. Any amendments are supported by the specification. Applicants accordingly submit that these claims are in a condition for allowance. Reconsideration and allowance of all claims are respectfully requested.

This response is submitted within the three month shortened statutory period for reply. Therefore, no extension of time fees are necessary. Authorization is hereby granted to debit or credit our Deposit Account No. 50-0206 for any fees or credits, including any extra claims fee.

Respectfully submitted,

HUNTON & WILLIAMS LLP

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By: Thomas D. Bradshaw

Thomas D. Bradshaw  
Registration No. 51,492

for Brian Buroker  
Registration No. 39,125

HUNTON & WILLIAMS LLP  
Intellectual Property Department  
1900 K Street, NW, Suite 1200  
Washington, DC 20006-1109  
(202) 955-1500 (Telephone)  
(202) 778-2201 (Facsimile)